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MAILED

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REEXAM UNIT

In re Reissue Application of
Jui-Teng Lin
Application No.: 10/626,486
Filed: July 24, 2003
For: U.S. Patent No. 6,263,879

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: DECISION, *SUA SPONTE*,
: TO MERGE
: REISSUE AND
: REEXAMINATION
: PROCEEDINGS

In re Jui-Teng Lin
Reexamination Proceeding
Control No.: 90/006,090
Filed: August 22, 2001
For: U.S. Patent No.: 6,263,879

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The above reissue application and reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged under 37 CFR 1.565(d) at this time.

REVIEW OF FACTS

1. U.S. Patent No. 6,263,879 (the '879 patent) issued on July 24, 2001.
2. A request for reexamination, assigned control No. 90/006,090 (the '6090 reexamination proceeding), was filed by a third party requester on August 22, 2001.
3. Reexamination was ordered for the '6090 reexamination proceeding on October 9, 2001.
4. A terminal disclaimer for the '879 patent was received from the patent owner on January 30, 2002.
5. A non-final Office action was mailed in the '6090 reexamination proceeding on May 28, 2003.

6. A response to the non-final Office action in the '6090 reexamination proceeding was received from the patent owner on July 21, 2003.
7. An application for reissue, assigned application No. 10/626,486 (the '6486 application), was filed by the patent owner on July 24, 2003.
8. A supplemental response to the non-final Office action in the '6090 reexamination proceeding was received from the patent owner on March 1, 2004.
9. A non-final Office action was mailed in the '6090 reexamination proceeding on April 29, 2005.
10. Notice of the filing of the reissue application was published in the *Official Gazette* on October 7, 2003.

DISCUSSION REGARDING MERGER

Under 37 CFR 1.565(d):

"If a reissue application and an *ex parte* reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to suspend one of the two proceedings."

As evidenced by the above review of facts, reissue application No. 10/626,486 and reexamination control No. 90/006,090 are currently pending. Since the order to reexamine has been mailed in the reexamination proceeding, a decision under 37 CFR 1.565(d) is timely.

The general policy of the Office is that a reissue application examination and a reexamination proceeding will not be conducted separately at the same time as to a particular patent. The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of both proceedings. In making a decision on whether or not to merge the two proceedings, consideration will be given to the status of each proceeding. See MPEP 2285.

In order to provide efficient and prompt handling of all proceedings and to prevent inconsistent, and possibly conflicting, amendments from being introduced on behalf of the patent owner, it is appropriate that the instant reissue and the reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the reissue application and the reexamination proceedings will be merged in accordance with the decision set forth below.

It is to be noted, however, that the grant of merger of a reissue application and an *ex parte* reexamination proceeding under 37 CFR 1.565(d) is discretionary. *The present merger is not an assurance that, in a future similar situation, merger would be ordered.*

DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

The above-captioned reissue and reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

II. Requirement for Same Amendments in Both Proceedings

1. The patent owner is required to maintain identical amendments in the reissue application and the reexamination proceeding files for purposes of the merged proceeding. The maintenance of identical amendments in both files is required as long as the proceedings remain merged. See 37 CFR 1.565(d).
2. A review of the reexamination file for the proceeding of reexamination control No. 90/006,090 shows that original patent claims 1-13 are present and claims 14-23 are added by amendment. A review of reissue application No. 10/626,486 shows that original patent claims 1-13 are present and claims 14-23 are added by amendment. Accordingly, the claims are identical in number, but may or may not be identical as to content in both proceedings.

If the claims are different as to content, an appropriate housekeeping amendment is required within ONE (1) MONTH of this decision placing the same amendments in both cases, specifically, Application No. 10/626,486, and Control Number 90/006,090. The response to the requirement must be limited to placing the same amendments in all cases, and patent owner must not address any issue of patentability in the housekeeping amendment.

If the claims are identical as to text, a patent owner statement to that effect is required within ONE (1) MONTH of this decision.

III. Conduct of the Merged Reissue Application Examination and Reexamination Proceedings

1. After the appropriate housekeeping amendment or statement as per Part II above is received, or after the time for same expires, the examiner should promptly prepare an Office action.
2. In the event that a housekeeping amendment is not timely submitted, any claim which does not contain identical text in both proceedings should be rejected under 35 U.S.C. 112, paragraph 2, as being indefinite as to the content of the claims, and thus failing to particularly point out the invention.
3. Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. 305 relating to the conduct of reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue-application examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding. However, periods of response should be set at TWO (2) months to comply with the statutory requirement for special dispatch in *ex parte* reexamination (35 U.S.C. 305).

4. Each Office action issued by the examiner will take the form of a single action which jointly applies to the reissue application and the reexamination proceeding. Each action will contain identifying data for both of the cases, i.e., the reissue application and the reexamination proceeding, and each action will be physically entered into both files (which will be maintained as separate files).
5. Any response by the applicant/patent owner must consist of a single response, with two copies being filed for entry into the two files, with each of the two bearing a signature. Any such responses must be served on the requester, who will also be sent copies of Office actions.
6. The filing of any amendments to the drawings, specification or claims must comply with the provisions for amendment in a reissue application set forth in 37 CFR 1.173, and the guidelines of MPEP § 1453. 37 CFR 1.121 does not apply to amendments in reissue. Accordingly, clean copies of the amended claims are not required and *are not to be submitted*. Instead, amendments are to be presented via markings pursuant to 37 CFR 1.173(d) of this section, except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.173(g), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the reissue application. Amendments are *not to be made relative to previous amendments*. Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from *the patent* appear in brackets.


7. Where a paper is filed which requires payment of a fee (e.g., petition fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for patent owner's appeal brief, even though the brief relates to merged multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding.
8. Upon return of the present merged proceeding to the examiner, the examiner will review the files to insure that each file contains identical citations of prior patents and printed publications, and the examiner will cite such documents as are necessary as part of the next action in order to place the files in that condition.
9. If the reissue application ultimately matures into a reissue patent, the reexamination proceeding shall be concluded by the grant of the reissue patent, and the reissue patent will serve as the certificate under 37 CFR 1.570. See MPEP 2285.
10. If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the reissue application will be held abandoned, and the merger will be dissolved. With respect to the reexamination proceeding, the Director will proceed to issue a reexamination certificate under 37 CFR 1.570 in accordance with the last action of the Office, unless further action is clearly needed as a result of the difference in rules relating to reexamination and reissue proceedings. For any further action in the reexamination proceeding, any grounds of rejection which are not applicable under reexamination would be withdrawn (e.g., based on public use or sale), and any new grounds of rejection which are applicable under reexamination (e.g., improperly broadened claims) would be made by the examiner upon dissolution of the merged proceeding. The

existence of any questions/issues remaining which cannot be considered under reexamination following the dissolution would be noted by the examiner as not being proper under reexamination pursuant to 37 CFR 1.552(c).

11. If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 CFR 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding, and continue examination as to the reexamination proceedings. Such examination would be conducted as set forth in the immediately preceding paragraph.

CONCLUSION

1. Reissue application No. 10/626,486 and reexamination control No. 90/006,090. ARE MERGED into a single consolidated proceeding. A copy of this merger decision will be made of record in both of the files.
2. Pursuant to Part II of this decision, to the extent the claims differ between the two proceedings, a housekeeping amendment is required within ONE MONTH of this decision, placing the same amendments in all cases of the present merged proceeding. **If the claims are identical as to text, a patent owner statement to that effect is required within ONE MONTH of this decision.**
3. The reissue and reexamination files are being forwarded to the examiner via the Director of Technology Center 3700. Upon receipt of same, the examiner should not issue an Office action for the present merged proceeding of the reissue and reexamination proceedings until after the earlier of (a) the submission of the housekeeping amendment to place the same amendments in both cases or a statement that the claims are identical as to text, or (b) the expiration of the ONE MONTH period (from the mailing of this decision) set in part 2 of the "Conclusion."
4. All further examination in the merged proceeding should be conducted in accordance with Part III of this decision.
5. Telephone inquiries related to this decision should be directed to Anton W. Fetting, Senior Legal Advisor, at (571) 272-7717.



Kenneth M. Schor
Senior Legal Advisor
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